



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,803	07/21/2003	Rudolf Bertagnoli	P07878US00/MP	3480
881 7590 03/26/2007 STITES & HARBISON PLLC 1199 NORTH FAIRFAX STREET SUITE 900 ALEXANDRIA, VA 22314			EXAMINER REIMERS, ANNETTE R	
			ART UNIT	PAPER NUMBER
			3733	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/26/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/622,803

Applicant(s)

BERTAGNOLI, RUDOLF

Examiner

Annette R. Reimers

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 19-35 is/are pending in the application.
- 4a) Of the above claim(s) 4, 13, 14, 19-21, 26-28, 31, 32 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-12, 22-25, 29, 30, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/21/03, 10/27/06 and 1/5/07 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action, for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant is reminded of the election with traverse of invention I, claims 1-14 and 19-21, Species I, frame, Figure 2, and Subspecies I, retaining structure, Figure 1, in the reply filed on August 18, 2005.

As previously stated in the last office action, elected frame, i.e. Species I, Figure 2, does not include three anchor screws securable to three adjacent vertebrae, the frame member having three arms, each having a tube engaging one of the anchor screws. The frame member having three arms is shown in Figure 11, which was not elected by applicant. In addition, the elected retaining structure, i.e. Subspecies 1, figure 1, does not include a retaining structure that is a non-threaded securing structure, a resilient cap, or a bayonet-type joint. These features are shown in the retaining structure of figure 10, which was not elected by applicant. Furthermore, it is noted from the reply filed on August 18, 2005 that applicant does not believe, and neither does examiner, that claim 4 reads on the elected species. As such, claim 28 is being withdrawn, since claim 28 is structurally similar to claim 4.

Claims 4, 13-14, 19-21, 26-28, 31-32 and 35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

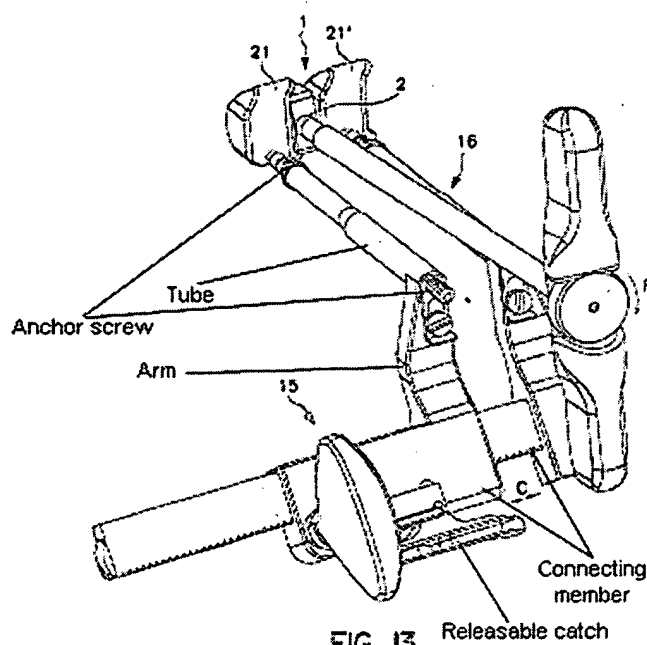
Claims 1-3, 5-12, 22-25, 29-30 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Bolger et al. (U.S. Patent Number 6,770,096) in view of Martin Benlloch et al. (U.S. Patent Number 6,676,661).

Bolger et al. disclose an instrument for spreading at least two adjacent vertebrae and/or retaining at least two adjacent vertebrae in a spaced apart condition, a frame member comprising at least two arms each arm having a tube, a connecting member, connecting the arms for movement of the arms toward and away from each other and a plurality of anchor screws (see figures 10- 12 and figure 13 below).

The connecting member comprises a connecting bar having two telescopic members, one arm connected to each of the telescopic members, such that telescopic movement of one of the telescopic members relative to the other causes the arms to move toward and away from each other (see figures 10-12 and figure 13 below). The inner of the two telescopic members being a toothed rod and the outer of the two telescopic members having a toothed wheel fixed thereto which engages the toothed rod for moving the two telescopic members relative to each other (see figures 10-12 and figure 13 below). A releasable catch is mounted on the outer of the telescopic members

Art Unit: 3733

and engaging the teeth on the inner of the telescopic members for permitting free movement of the two telescopic members relative to each other in one direction but stopping movement of the two telescopic members relative to each other in the other direction (see figures 10-12 and figure 13 below).



Bolger et al. disclose the claimed invention except for a retaining structure for securing each of the anchor screws to its respective tube, wherein the retaining structure engages the rear end of the anchor screw and securely tightens it against the rear end of the tube, and wherein the retaining structure comprises a threaded nut, which threadedly engages the rear end of the anchor screw. Martin Benlloch et al. disclose an anchor screw, 3, with a threaded nut, 9, and teach the use of the threaded nut with the anchor screw in order to immobilize the screw in terms of rotation (see

Art Unit: 3733

figure 1 and column 2, lines 7-18). It would have been obvious to one skilled in the art at the time the invention was made to construct the distraction device of Bolger et al. with a retaining structure for securing each of the anchor screws to its respective tube, wherein the retaining structure engages the rear end of the anchor screw and securely tightens it against the rear end of the tube, and wherein the retaining structure comprises a threaded nut, which threadedly engages the rear end of the anchor screw, in view of Martin Benlloch et al., in order to immobilize the screw in terms of rotation. Moreover, it is well known in the art that threaded nuts are used as retaining structures for screws.

Response to Arguments

Applicant's arguments filed on October 27, 2006 have been fully considered, but they are not persuasive. Examiner respectfully disagrees with applicant regarding the Bolger et al. and Martin Benlloch et al. references. The exposed threaded ends of the anchoring screws of Bolger et al. are each capable of being secured with a retaining structure, i.e., a threaded nut, as disclosed in the Martin Benlloch et al. Examiner cited Bolger et al. in view of Martin Benlloch et al. specifically for the retaining structure, i.e., threaded nut 9, which is used to retain anchoring screw 3. Examiner is aware that the device of Martin Benlloch et al. is not a distraction device. However, as stated above, Martin Benlloch et al. was cited for the use of an anchoring screw/retaining structure combination. As previously stated, Bolger et al. disclose the claimed invention "except for a retaining structure for securing each of the anchor screws to its respective tube," wherein the retaining structure engages the rear end of the anchor screw and securely

Art Unit: 3733

tightens it against the rear end of the tube, and wherein the retaining structure comprises a threaded nut, which threadedly engages the rear end of the anchor screw. Martin Benlloch et al. disclose an anchor screw, 3, with a threaded nut, 9, and teach the use of the threaded nut with the anchor screw in order to immobilize the screw in terms of rotation (see figure 1 and column 2, lines 7-18). It would have been obvious to one skilled in the art at the time the invention was made to construct the distraction device of Bolger et al. with a retaining structure for securing each of the anchor screws to its respective tube, wherein the retaining structure engages the rear end of the anchor screw and securely tightens it against the rear end of the tube, and wherein the retaining structure comprises a threaded nut, which threadedly engages the rear end of the anchor screw, in view of Martin Benlloch et al., in order to immobilize the screw in terms of rotation. Moreover, it is well known in the art that threaded nuts are used as retaining structures for screws.

Furthermore, Bolger et al. does not teach away from the use of retaining structures, such as threaded nuts, on the anchoring screws. It is silent as to the use of a retaining structure. As stated above, the exposed threaded ends of the anchoring screws of Bolger et al. are each capable of being secured with a retaining structure, i.e., a threaded nut, as disclosed in Martin Benlloch et al. In addition, applicant has stated that the claimed invention is an improvement, (i.e., a Jepson claim), however the claims have not been addressed in this manner (see MPEP 2129 III). Furthermore, it is noted that the features upon which applicant relies (i.e., "The present invention has overcome the disadvantages of the prior art by providing a secure engagement between the arms

Art Unit: 3733

and the anchor screws, sufficiently secure that as the arms are moved apart, the anchor screw maintain their original alignment") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER